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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,919	04/12/2004	Valerie De La Poterie	05725.1266-00000	2430
22852	7590	06/18/2009		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER VENKAT, JYOTHSNA A	
			ART UNIT	PAPER NUMBER
			1619	
			MAIL DATE	DELIVERY MODE
			06/18/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/821,919

Applicant(s)

DE LA POTERIE, VALERIE

Examiner

JYOTHSNA A. VENKAT

Art Unit

1619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-11,13,18,21,24,28,32 and 34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-11,13,18,21,24,28,32 and 34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 4/9/09
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/9/09 has been entered.

Receipt is also acknowledged of declaration under 37 C.F.R. § 1.132 and IDS filed on 4/16/09. Claim 33 has been canceled as per applicants' amendment dated 4/9/09.

Status of claims

Claims 4, 14-17, 20, 22-23, 25-27, 29-31, 33 and 36-39 are cancelled. Claims 35 and 40 are withdrawn from consideration as being drawn to non-elected invention (election without traverse dated 11/13/07). Claims 12 and 19 are withdrawn from consideration as being drawn to non-elected species (election without traverse dated 11/13/07).Claims 1-3, 5-11, 13, 18, 21, 24, 28 and 32 and 34 are pending and currently examine din the application in the application.

Claims 1, 13, 32 and 34 are examined to the extent that it reads on the elected species “polystyaryl acrylate” and gum arabic as the film forming polymer.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3, 5-11, 13, 18, 21, 24, 28 and 32 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is unclear and lacks clarity with respect to II 3-6 because the expression “thermal profile having a melting peak wherein the mid-height width L_f is less than or equal to 20 degrees Celsius” is repeated twice.

Claim Rejections - 35 USC § 102

Claims 1-3, 5-11, 13, 18, 21, 28 and 32 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by U. S. Patent 3,911,105.

Specification teaches the measurement for measuring thermal profile. See below.

Determination of the thermal profile of the composition

[022] The thermal profile of the composition according to the present disclosure is determined using a differential scanning calorimeter (DSC), for example the calorimeter sold under the name DSC 30 by the company Mettler.

See claim 5 of patent for “elected species” polystearyl acrylate. See col.5, ll 37-40 for water (aqueous phase of instant claim 21) and see col.4, ll 49-65 for instant claim 28 drawn to dyestuff. Examples 26-28 read on instant claim 1 and remaining examples read on claims 32 and 34.

PTO is not equipped to measure the thermal profile and the limitations claimed in claims 2-3 and 5-11, are also anticipated by patent ‘105.

Response to Arguments

Applicant's arguments filed 4/9/09 have been fully considered but they are not persuasive.

Applicants' argue:

'The Examiner alleges that the disclosure of polystyaryl methacrylate in col. 3, lines 65-66, of the '105 patent is actually a disclosure of polystyaryl acrylate, which Applicant has elected, and that "the components claimed are [the] same as ... that disclosed." Final Office Action at 3. Without acceding to these allegations, Applicant submits that the '105 patent does not disclose each and every element of Applicant's claimed invention as recited in amended independent claim 1. This is at least because the '105 patent does not disclose

[a] cosmetic composition comprising, in a physiologically acceptable medium, at least one compound which gives the cosmetic composition a thermal profile having a melting peak wherein the mid-height width Lf is less than or equal to 20°C, the at least one compound having a thermal profile having a melting peak wherein the mid-height width Lf is less than or equal to 20°C ... wherein the cosmetic composition is heat-stable as recited in amended independent claim 1 “.

In response to the above argument, patent at col.3, ll 65-66 does not disclose the elected species **but claim 5 is drawn to elected species.**

Regarding the functional language recited in claims 1 and 32, PTO is not equipped to measure the thermal profile recited in claim 1 and with respect to claim 32, which does not recite the determination of thermal profile, PTO is not equipped to measure the thermal profile describe din the specification.

Applicants' submit declaration under 1.132 to show that the compositions of patent '105 are not heat stable.

Response to Amendment

The declaration under 37 CFR 1.132 filed 4/9/09 is insufficient to overcome the rejection of claims rejected under 102(b) based upon patent 3,911,105 ('105) as set forth in the last Office action because of the following reasons:

1. Applicants' state in the declaration that only example 29 of patent is directed to mascara which may use polystearyl methacrylate. **Applicants' did not test "polystearyl methacrvlate "of example 8** instead tested "polystearyl acrylate-dimethicone methacrylate copolymer". This is not drawn to example 8 (**emphasis added**).

2. Applicants' also state in the declaration that in composition A " polyvinyl stearate" was not available at the time of testing therefore this polymer was replaced by " polyvinyl laurate". Is polyvinyl stearate not available from any vendor?

3. Clarification is requested with respect to discrepancy in the amount of first three ingredients tested in compositions A and B vs. the amounts disclosed in the patent '105.

What is the physiologically accepted medium in example 29?

4. Examples 29-30 are drawn to "anhydrous mascara", whereas example 1 of instant specification uses water. The closest art in patent '105 are also examples 26-28, which use water.

Therefore the declaration submitted to show that the compositions of patent '105 are not heat stable is unpersuasive.

Claim Rejections - 35 USC § 103

Claims 1-3, 5-14, 18, 21, 24, 28 and 31-34 rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patents 3,911,105 ('105) and 6,875,245 ('245).

Patent '105 teaches cosmetic composition using polystearyl acrylate, aqueous phase and dyestuff and use these compositions in the form of lipstick and mascara. Patent does not teach the limitation of claim 24, wherein the composition further comprising film-forming polymer, which is gum arabic (elected species). Patent '245 teaches compositions in personal care products. Personal care products are also known as cosmetic compositions. Patent '245 under examples 8-9, 25 and 66 teaches mascara compositions using gum arabic. Thus both the patents teach individually mascara compositions using polystearyl acrylate and gum arabic.

Accordingly it would be obvious to one of ordinary skill in the art at the time the invention was made to prepare third composition and use it for coating keratin fibers (mascara) by combining the two components polystearyl acrylate and gum arabic with the reasonable expectation of success that the third composition is also effective for coating the keratin fibers. It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. The idea of combining them flows logically from their having been individually taught in the prior art.

Response to Arguments

Applicant's arguments filed 5/8/08 have been fully considered but they are not persuasive.

Applicants' argue that the declaration showed the compositions of patent '105 are not heat stable and patent '245 does not disclose or suggest a composition that is heat stable required by claims and therefore heat stability required by claim 1 is not a resulting property of combination of patents '105 and '245.

In response to the above argument, the evidence presented to show that the compositions of patent '105 are not heat stable is unpersuasive for the reasons stated above and the claims are prima facie obvious since patent '105 teaches all the limitations except film forming polymer (claimed species) and both the patents teaches mascara compositions and it is prima facie obvious to prepare a third composition by combining two compositions which are also used for the same purpose.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30: 1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JYOTHSNA A VENKAT /
Primary Examiner, Art Unit 1619